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Paper 9

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OFFICE OF PETITIONS

In re Application of :
Petrie, et al : **DECISION ON PETITION**
Application No. 09/693,213 :
Filed: 19 October, 2000 :
Attorney Docket No. 17682A-005100US :

This is a decision on the petition under ¶(a) of 37 C.F.R. §1.47,¹ filed on 16 January 2001, but not delivered to the Office of Petitions until this writing.

The Office regrets the delay in addressing this matter.

The petition is **DISMISSED**.

NOTE: Any request for reconsideration of this decision must be submitted (with fee) within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. Any response (with fee) should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(a)" and

¹ The regulations at 37 C.F.R. §1.47 provide:

§1.47 Filing when an inventor refuses to sign or cannot be reached.

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in §1.17(h), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with §1.63.

(b) Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in §1.17(h), and the last known address of all of the inventors. An inventor may subsequently join in the application by filing an oath or declaration complying with §1.63.

© The Office will send notice of the filing of the application to all inventors who have not joined in the application at the address(es) provided in the petition under this section, and publish notice of the filing of the application in the *Official Gazette*. The Office may dispense with this notice provision in a continuation or divisional application, if notice regarding the filing of the prior application was given to the nonsigning inventor(s).

[47 Fed. Reg. 41275, Sept. 17, 1982, effective Oct. 1, 1982; 48 Fed. Reg. 2709, Jan. 20, 1983, effective Feb. 27, 1983; revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 Fed. Reg. 54604, Sept. 8, 2000, effective Nov. 7, 2000]

may include an oath or declaration executed by the inventor.

Failure to respond within the time set forth above will result in abandonment of the application.

BACKGROUND

The record indicates:

- the application was filed on 19 October, 2000, without, *inter alia*, a fully executed oath or declaration;
- in response to a 15 November, 2000, Notice to File Missing Parts, on 16 January, 2001, Petitioner filed (over a 12 January, 2001, certificate of mailing) the instant petition and fee, a statement in support, and a oath/declaration signed by inventors, save co-inventor Gerald D. Hurst (Mr. Hurst);
- the record clearly suggests that a copy of the entire application (specification (description, claims, abstract) and drawings) was not sent to non-signing co-inventor Mr. Hurst, and there is certainly no explicit evidence of such in the form of a copy of the transmittal letter;
- the petition and statement of Counsel do not clarify this matter;
- a call was made to the Counsel's office on 19 November, 2002, to review this matter with him and request the requisite evidence (i.e., transmittal letters).

ANALYSIS

A copy of the entire application must be sent to the last known address of the non-signing inventor with a request that he/she sign the declaration for the patent application--and evidence of that transmittal submitted. (Additionally, Petitioner must state for the record that last known address. A forwarding address should be requested if the papers are returned, and other attempts to locate the inventor (e.g. through e-mail or the telephone) continue to fail, then applicant will have established that the inventor cannot be reached.)

Alternatively, an oath or declaration for the patent application in compliance with 37 C.F.R. §§1.63 and 1.64 must be presented.

The declaration must set forth the inventor's residence, citizenship and post office address. An oath or declaration in compliance with 37 C.F.R. §§1.63 and 1.64 signed by the Rule 1.47

applicant is required.²

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner of Patents and Trademarks
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite CP4-3C23
2201 South Clark Place
Arlington, VA 22202

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.



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² See: MPEP 409.03(b).